

## REMARKS/ARGUMENTS

By this paper, Applicant notes deficiencies in the Notice of April 18, 2007 and respectfully requests resetting of the time for reply. In the alternative, this paper requests reconsideration of any requirement therein. The shortened statutory period runs through May 18, 2007. Accordingly, this reply is timely.

Claims 2, 4 and 6-33 are now pending, a total of 30 claims. Claims 2, 18 and 25 are independent.

### **I. Request For Complete Office Action and To Reset Period Pursuant to MPEP § 706.10**

Pursuant to MPEP § 710.06, Applicant calls to the attention of the Office several errors in the Office's paper of April 18, 2007, and requests that the Office reissue the paper in corrected and completed form and reset the period for reply. MPEP § 710.06 reads as follows:

#### **710.06 Situations When Reply Period Is Reset or Restarted**

Where an Office action ... contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. ...

The Notice of April 18, 2007 contains the following errors that affect Applicant's ability to reply. Applicant requests a correction and restart.

1. When an Office Action states reasons for a requirement that do not align with the reasons authorized in the MPEP, the MPEP controls, and the Office Action is either void, or at most effective only to the extent authorized by the MPEP. Applicants can reply when the relevant legal concerns are set out in the MPEP, because those concerns are familiar and consistent with the practices of other examiners. However, when an Examiner strikes out on unfamiliar, unwritten ground, applicants cannot meaningfully reply. This Applicant cannot reply to unfamiliar questions that do not have some basis in the MPEP or some other published document having force of law.
2. Paragraph 3 of the April 2007 paper asserts that there is an "originally acted upon invention." Kindly identify a particular section of a document having "force of law" that describes the legal principle raised in ¶ 3 of the April 2007 paper (the MPEP does not have "force of law," MPEP Foreword), and that applies in a case where there has been no first Action on the merits. When an Examiner departs from the MPEP's form language, the nature of the Examiner's concerns are not clear, and an applicant cannot reply. There is no paper in Applicant's file or the IFW reflecting and "action on" any invention on the

merits. If there is, kindly identify the invention that was “acted upon,” and the Office paper that “acted” on the merits of the identified invention.

3. At several points, the April 2007 paper suggests that the only basis on which to traverse an election-type restriction requirement is to state that species are “obvious variants.” Applicant cannot reply until the Examiner acknowledges that other bases for traverse exist, including at least the “unduly extensive and burdensome search” requirement of MPEP § 803(I)(B) and § 806.01, the failure to make factual showings as required by MPEP § 803(II), the all-capital language of MPEP § 803.01, the “reasonable number” provision of 37 C.F.R. § 1.146 and MPEP § 806.04, the “claims are never species” requirement of MPEP § 806.04(e), and the “mutually exclusive” requirement of MPEP § 806.04(f).
4. The April 2007 paper asserts there is a “serious search burden.” MPEP § 803(I)(B), § 803(II) ¶ 4, and § 806.01 requires “Examiners must provide reasons and/or examples to support conclusions” of “unduly extensive and burdensome search,” for example, by “appropriate explanation of separate classification, or separate status in the art, or a different field of search.” The statements in the April 2007 paper do not relate to the grounds stated in MPEP § 803(II) ¶ 4. Applicant is unable to reply until the Examiner has stated “reasons and/or examples to support conclusions” that relate to relevant criteria.

It appears that Applicant and Examiner are in agreement, that the various species are “independent and distinct” from each other: as the April 2007 paper reiterates several times, the species are not obvious variants and are materially different from each other. The relevance of the discussion of paragraph 4 of the April 2007 paper – which appear to be directed only to showing “independent and distinct” – is not understood.

a provisional election of a single species may be required where only generic claims are presented and the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary.

MPEP § 806.01 (emphasis added). The issue raised in the January 29, 2007 reply, and reiterated here, is that neither the January 2007 paper nor the April 2007 paper makes any showing of “unduly extensive and burdensome search” using the criteria of MPEP § 803(II) ¶ 4. Until the Examiner makes a *prima facie* showing on the “unduly extensive and burdensome search” prong of any restriction, and “Answers All Material Traversed” in the January 29, 2007 paper, Applicant is unable to reply.

5. A requirement under 37 C.F.R. § 1.146 permits an applicant to elect a “reasonable” number of species. What is a “reasonable” number, in view of the filing fees paid, and what published document articulates a standard?<sup>1</sup> The mere fact that claims may cover a “multitude of ways [to practice] the claimed invention” has never been relevant to determining “unduly extensive and burdensome search.” Without some showing that this

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<sup>1</sup> See *Ex parte Maloney*, 1999 WL 33205694 at \*2, [www.uspto.gov/go/dcom/bpai/decisions/fd983299.pdf](http://www.uspto.gov/go/dcom/bpai/decisions/fd983299.pdf) at pp. 4-5 (Bd. Pat. App & Interf. May 24, 1999) (“it is well established that an applicant has the choice of deciding as to the number of claims so long as they are consistent with the disclosure and the requisite filing fees are paid.”).

case is an exception, and some articulation of the Office's expectations in a published document, no reply is possible.

6. MPEP § 806.04(f) permits a requirement to elect only "if the species are mutually exclusive." The January 2007 Office paper conceded in ¶ 5 that the claims do overlap in scope. How does § 806.04(f) apply in such a situation? If the Examiner believes that election among *non-mutually-exclusive* "inventions" of overlapping scope is authorized by the MPEP, Applicant requests identification of the particular MPEP section that overrides § 806.04(f). Until there is some common understanding of the meaning of MPEP § 806.04(f), Applicant is unable to reply.
7. Paragraph 5 of the January 2007 Action requests that "a single species election must be closed ended" (Action of 1/17/2007, ¶ 5). The definition of "single species election" used in the Office Action appears to be contrary to the definitions of "generic" and "mutually exclusive" of MPEP §§ 806.04(d) and 806.04(f), and an applicant's right to designate a "reasonable number of species" granted by 37 C.F.R. § 1.146 and MPEP § 806.04. Paragraph 5 appears to be outside the authority delegated to the Examiner by the Office. If the Examiner disagrees, Applicant requests an explanation for how the requirement is consonant with these provisions. This issue was raised in Applicant's paper of January 29, 2007. No reply to the April 2007 paper is possible until the Examiner "Answers All Material Traversed" as required by MPEP § 707.07(f). Until Applicant understands the rules that the Examiner believes to apply, Applicant is unable to reply. When the Examiner relies on the MPEP, this understanding is easy. When an Examiner goes outside the MPEP, the Examiner must fully explain the legal basis for any requirement, including a citation to a document having force of law.
8. Paragraph 2 of the January 2007 paper requests an election of species within the election of paragraphs 1, paragraph 3 requests an election within the election of paragraphs 1-2, and paragraph 4 requests an election within the election of paragraphs 1-3. Is the Examiner suggesting that he will only examine an "imaginary claim," a combination of limitations that does not exist in any claim? Applicant does not understand how to reply to a requirement that does not relate to the claims.<sup>2</sup>
9. Paragraph 6 of the April 2007 paper reasserts the requirement of paragraph 4 of the January 2007 paper. In view of cancellation of claim 5, is paragraph 4 now moot? Applicant is unable to determine what question is being asked, let alone reply.
10. Paragraph 7 of the April 2007 paper raises a "new matter" issue. Under what statute or rule is material that was not amended into the specification or the claims "new matter?" Unless there is some recognizable principle of law invoked, Applicant cannot reply.

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<sup>2</sup> The January 2007 paper, ¶ 3, asked Applicant to "elect **a single species of exactly what trading price is being monitored**" (emphasis in original). Applicant answered exactly the question asked. The Examiner appears unsatisfied with the answer provided. Applicant suggests that the Examiner's dissatisfaction may be reflective of the Examiner's own departure from the familiar procedures authorized by the MPEP. Applicants cannot read examiners' minds. When an Examiner asks a question that does not correlate to the MPEP, an Applicant can at most reply to the exact question asked.

Applicant believes that most of the questions and requirements asked in the Actions of January 2007 and April 2007 are beyond those permitted by the MPEP. Departure from the MPEP will lead to confusion, frustration at lack of clearly communicated expectations, and delay. Applicant respectfully urges that the MPEP provides a set of principles that Applicant and Examiner can expect of each other. If expectations are shared, prosecution will proceed much more efficiently.

If there is some basis for requiring restriction that complies with all requirements stated in all MPEP and 37 C.F.R. sections noted above and in the January 29, 2007 reply, Applicant requests a clear and internally-consistent statement, and will reply.

## **II. Election with Traverse**

Applicant believes that the Examiner will find that many of the above questions cannot be answered, and will concur that no restriction requirement exists. Without waiving the requests set forth above, and solely to prevent abandonment of the application, a provisional reply is set forth as follows. Applicant is not bound by this reply, because it is subject to revision based on a complete Action answering all questions set forth above.

**Paragraph 1 of the January 2007 paper.** Applicant provisionally elects all claims readable on the embodiments of ¶ 1(b). Claims 2, 4 and 6-33 are readable on elected group 1(b).

**Paragraph 2 of the January 2007 paper.** Applicant provisionally elects all claims readable on embodiments “compris[ing] determining a mode trading price.” Claims 2, 4, 6-7, 9-10, 13-20, 22-29, and 31-33 are readable on “mode” species.

**Paragraph 3 of the January 2007 paper.** Applicant provisionally elects claims readable on electricity. Claims 2, 4 and 6-33 are readable on species involving electricity.

**Paragraph 4 of the January 2007 paper.** Claim 5 is cancelled. Applicant is unable to reply.

## **III. Conclusion**

Should any requirement be made final, the Examiner is respectfully requested to state on the record that the claims in each group are patentable (novel and nonobvious) over each other.

Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. CF/047 – 01-1047.

Respectfully submitted,

Dated: May 18, 2007

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